

REMARKS

Claims 1-12, 14-44, and 63-84 are pending. Previously canceled claims 51 and 53 are reintroduced, with changes in the case of claim 53, as claims 80 and 82.

Claims 1-25, 31-39, and 63-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Okazaki et al., U.S. Patent 6,495,862 (hereinafter "Okazaki"). Applicants respectfully traverse the rejection.

Claim 1 is amended to include the elements of claim 13. Claim 1 now recite an "optical element . . . bonded to a surface of said stack, and wherein a smallest ratio of a length of a base of said optical element to a length of said surface is greater than one." Thus, the length of the base of the optical element is greater than the length of the surface of the stack on which the optical element is bonded. In each of Figs. 9 and 10 of Okazaki, the length of the base of layers 20 and 22 is the same as the length of the surface on which layers 20 and 22 are bonded. Accordingly, Okazaki does not anticipate claim 1.

Claims 2-25, 31, 33-39, 63, and 64 depend from claim 1 and are therefore allowable over Okazaki for at least the same reason.

Claim 32 recites "a transparent bonding layer comprising a material different from a material forming the optical element, the transparent bonding layer being disposed between said optical element and a surface of said stack and bonding said optical element to said stack." Applicant can find no such teaching in Okazaki. Applicants show no layer at all between the stack of semiconductor layers and layers 20/22, much less a layer of a material different from layers 20/22.

With regard to claim 32, the Examiner states "regarding the transparent bonding layer, the device of Okazaki et al. inherently has a bonding layer between the semiconductor and the transparent optical element (20/22) even though one is not explicitly shown or addressed." The Examiner's statement that there is an inherent bonding layer different from the optical

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element between the stack and the optical element is incorrect. The test for inherency is set forth in MPEP section 2163.07(a), quoting *In re Robertson*: "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Emphasis added, citations omitted. Thus, for the bonding layer to be inherent, it must be necessarily present in every embodiment of Okazaki's Figs. 9 and 10. At column 10, lines 39-41, Okazaki states "useable as the material of the light lead-out layer 20 are, for example, resin or other organic materials." Other organic materials may include, for example, epoxy, which may readily be disposed on Okazaki's device without an additional, different bonding layer. Accordingly, since at least one of Okazaki's embodiments does not necessarily require a bonding layer of a material different from the optical element as recited in claim 32, this limitation of claim 32 is not inherent in Okazaki. Therefore, Okazaki does not anticipate claim 32.

Claims 65-71 depend from claim 32 and are therefore allowable over Okazaki for at least the same reason as claim 32.

Claims 26-30, 40-44, and 72-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazaki et al. These claims depend from claims 1 and 32 and are therefore allowable over Okazaki for at least the same reasons as claims 1 and 32.

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In view of the above arguments, Applicants respectfully request allowance of all claims. Should the Examiner have any questions, the Examiner is invited to call the undersigned at (408) 382-0480.

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Signature Date

Respectfully submitted,

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